

**REMARKS**

Applicants request reconsideration and reexamination of the above-identified application. The following remarks state Applicants' bases for making this request and are organized according to the Examiner's Action.

**CLAIM REJECTIONS – 35 U.S.C. § 101**

The Examiner states that Claims 9-11 and 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to an instructional method. While it is understood from the specification that an apparatus is used in the method, Claim 9 does not explicitly recite any apparatus as part of the invention. The Examiner further states that the method steps as recited in Claim 9 consist of instruction a child about various rules and such, and that such instructional method are not patentable under 35 U.S.C. 101. While processes are one of the four categories of patentable inventions, it does not follow that all processes are therefore patentable. The Examiner points out that it is well settled that laws of nature, natural phenomenon and abstract ideas are not by themselves, patentable subject.

However, Applicants have amended Claims 9-11 to overcome the non-statutory subject matter rejection by claiming a method that produces useful, concrete and tangible results. In particular Claim 9 now calls for:

“attaching to a peg on a base panel and displaying on said base panel a positive reinforcer card when said child performs desired behavior or acts;....attaching to said peg and displaying on said base panel a punisher card when said child performs undesirable behavior or acts;... .”

Applicants believe that Claim 9 now creates useful, tangible, and concrete results by the recitation of a method with the steps of attaching a positive reinforcer card to a peg and

attaching a punisher card to said peg, which is not suggested in the prior art. Instead Buckley discloses pockets. Applicant believes that Claim 9 is now patentable.

Applicant has amended Claims 10 and 11 which are dependent on Claim 9 are now creates useful, tangible, and concrete results. Claims 10 and 11 are dependent on patentable Claim 9, so they are likewise patentable.

In regard to Claim 14, it was dependent on Claim 4 which is dependent on Claim 1. Applicants are amending Claim 14 to recite the step of "flipping said card from the positively reinforcer front-side to the punishing back-side provides a parent, caregiver or educator with a running record of undesirable behavior. Claim 4 is canceled, and Claim 14 is amended to be dependent on Claim 3 which is dependent on Claim 1. Applicants believe that the invention attributes in Claim 14 along with the limitation in Claim 3 provides useful, concrete, and tangible results as required by 35 U.S.C. 101.

Method Claim 15 is canceled, and method Claim 16 is amended to correct the preamble wording and to make it definite. Claim 16 is dependent on amended Claim 9 which is now believed to be patentable.

Method Claim 17 is canceled and method Claims 18 and 19 which are dependent on Claim 9, are amended to correct preamble wording and to be more definite.

Method Claim 20 is amended to be definite and patentable, and Claim 20 is dependent on patentable Claim 9.

Applicants now believe that Claims 14, 16, 18-20 are now definite and patentable under 35 U.S.C. 101.

#### **CLAIM REJECTIONS – 35 U.S.C. § 112**

The Examiner states that Claims 3-5, 10, 11 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 3-5 are apparatus claims;

however, no further limitations to the apparatus are recited. Rather, the claims recite only functional language which describes the intended purpose of the apparatus.

Applicants have canceled Claim 4 and added the attributes in Claim 4 to Claim 3. Further, Claim 3 is being amended to include the following added limitation: "said device comprises means on the back-side of said base panel for mounting said based panel on a surface which enable a parent which enables a parent, caregiver or educator to instruct a child that when the card is turned front-side out, the marking indicia correspond to a positive reinforcer or reward for the child, and when the card is turned back-side out, the marking indicia correspond to removal of a positive reinforcer or reward". Applicants believe that Claim 3 as amended, which is dependent on Claim 1 is now definite and patentable. Claim 5 is dependent on Claim 3 so it also is patentable.

The Examiner states that the use of the term "optionally" in Claim 10 and 11 renders these claims indefinite; it is unclear what, precisely, the scope of the claims is.

Applicants do not see the word "optionally" in Claims 10 and 11 and maybe the Examiner was referring to the word "operationally". Applicants are deleting this word because it is not necessary, in addition to further amending Claim 10 to be more definite. Claim 11 is amended similarly to Claim 10 to make it more definite. Claims 10 and 11 are dependent on Claim 9, and Applicants believe that Claim 9 is now patentable so Claims 10 and 11 are likewise patentable.

The Examiner states that in Claim 20 the phrase "varying shapes including a circle or a rectangle" is indefinite. Applicants have amended Claim 20 to call for "...one of a plurality of shapes including a circle or a rectangle", and Applicants believe that Claim 20 is now definite and patentable. Therefore, Applicants believe that Claims 3, 5, 10, 11 and 20 as amended are now definite and patentable.

**CLAIM REJECTIONS – 35 U.S.C. § 103**

The Examiner states that Claims 1-5, 9-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Makow. The claims are directed to a device for tracking behavior, where positive reinforcement cards and punisher cards are selectively placed on a base panel. Buckley discloses in Figures 1-3 and in column 3, line 41 to column 4, line 34 of the specification a behavior tracking device comprising a base panel 10, on which various tab cards 16 are placed. As described at column 8, lines 1-47, the tab cards include positive reinforcement cards 16b having indicia thereon representing positive reinforcement for performing a favorable act, and consequence cards 16d, which essentially amount to punisher cards and have indicia thereon representing a punishment for performing an unfavorable act. As described at column 8, lines 42-47 of Buckley, the positive reinforcement cards and the consequence cards are placed on the board 10 and added up to represent a score. Buckley further discloses, in column 9, lines 11-18 and in column 10, lines 8-44 that tangible rewards including play money, toys, candy and so forth may be awarded to the child for positive behavior.

However, Applicants wish to point out that Buckley teaches the insertion or placement of tab cards 16 into a plurality of play pockets 13. The present invention teaches the attaching, placing, or hanging removable cards on posts or plugs. Therefore, Applicants have amended Claim 1 to specifically call for "...at least one removable card attached to at least one peg on the front of said base panel...", and likewise, Applicants have amended Claim 9 to call for "...attaching to a peg on a base panel and displaying on said base panel a positive reinforcer card when said child performs desired behavior or acts;". Also, in Claim 9, it calls for "attaching to said peg and displaying on said base panel a punisher card when said child performs undesirable behavior or acts."

As pointed out by the Examiner, the prior art does not disclose attaching the cards of this behavior modification device to pegs. The Examiner further states that Buckley fails to

disclose that positive reinforcement indicia and punishment indicia are provided on the opposite sides of the same card, but that cards having indicia on each side, to be selectively displayed by the user, is known. Makow discloses in Figures 3a and 3b and in column 8, lines 30-42 a device comprising cards 13, where each card has an indicia indicating one concept on one side (devil's fork 13a) and an indicia for indicating the opposite concept on the other side (halo 13b). The Examiner states that it would have been obvious to one of ordinary skill in the relevant art to modify the device of Buckley by providing cards which have "reward" indicia on one side and "punishment" indicia on the other side for the purpose of allowing a user to use a single card to express either of the two concepts.

However, the teachings of Makow are moot because Claims 1 and 9 as amended are not obvious from Buckley alone which discloses pockets not pegs, and Makow only teaches using cards with a different indicia of each side.

Therefore, Applicants believe that Claims 1 and 9 as amended and the claims dependent thereon are not obvious from Buckley in view of Makow and that they are patentable.

#### **ALLOWABLE SUBJECT MATTER**

The Examiner states that Claims 21-33 are allowed and provides the following statement of reasons for the indication of allowable subject matter: The prior art fails to disclose a device or method having all of the limitations of Claims 21 and 28. In particular, the recitation of a plurality of pegs, with a means for attaching a double-sided card as recited to one of the pegs, is not suggested. Because means-plus-function language is used, the claims must be examined under 35 U.S.C. 112, ¶ 6, which dictates that such language is to be interpreted in light of the specification. That is, the prior art must disclose or suggest a device which performs substantially the same function as the claimed invention in substantially the same way. In this case, viewing the specification, the Examiner states that there is no

suggestion in the prior art of a device which performs the claimed function in substantially the same way. Buckley discloses pockets, which are used in a different fashion from the pegs of the present invention. As a result, Claims 21 and 38, and all claim dependent therefrom, are allowed.

In view of the above, it is submitted that Claims 1-3, 5, 9-11, 14, 16 and 18-33 as amended are now in condition for allowance. Reconsideration of the rejections to the Claims is respectfully requested. Accordingly, it is requested that these claims be allowed and the case be sent to issue.

If there are any questions, we urge the Examiner to call us. Please charge any costs in connection with this document to our Deposit Account No. 16-0875.

Respectfully Submitted,  
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By



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